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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,232	09/26/2001	Ronald M. Burch	200.1125CON	1215

23280 7590 04/21/2003

DAVIDSON, DAVIDSON & KAPPEL, LLC  
485 SEVENTH AVENUE, 14TH FLOOR  
NEW YORK, NY 10018

EXAMINER

WESSENDORF, TERESA D

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 04/21/2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/963,232

Applicant(s)

BURCH ET AL.

Examiner

T. D. Wessendorf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-91 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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**DETAILED ACTION**

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Andrew Wang, Supervisory Patent Examiner (703) 306-3217. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23 and 75-78, drawn to method of defining (identifying) a portion or fragment of a compound, classified in class 435, subclass 7.1.
- II. Claims 24-43, drawn to method of identifying compounds which have binding affinity for a target receptor, classified in class 435, subclass 7.1.
- III. Claims 44-48, 63-74, drawn to a method of identifying a portion of PDE IV inhibitors, classified in class 435, subclass 7.4.

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IV. Claims 49-53 and 79-91, drawn to method of identifying compounds which inhibit PDE IV by screening, classified in class 435, subclass 4+.

V. Claims 54-62, drawn to a method of designing a three-dimensional structure, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons: Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are independent methods having different modes of operation and practicing the method yield different products.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

For Group I:

A). Functional Groups:

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1. Carboxyl
2. Hydroxyl
3. Keto
4. Amino
5. Nitro
6. Sulfhydryl

B). Chemical Groups:

1. Organic
2. Inorganic
3. Biological molecules

Each of the species under SubGroup A and SubGroup B are structurally distinct and would possibly have different mode of actions or operations. Each of the different species would therefore require different patentability determinations under the different statutes.

For Group II:

A). Functional Groups:

1. Carboxyl
2. Hydroxyl
3. Keto
4. Amino
5. Nitro
6. Sulfhydryl

B). Source of compound:

1. Combinatorial library:
  - i. Peptide
  - ii. Ethers
  - iii. Phosphonates
2. Natural product extracts
3. Microbial or other cell culture broths
4. Synthetic products
5. Synthetic analogs
6. Intermediates

C). Chemical Groups:

1. Organic
2. Inorganic
3. Biological molecules

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Each of the species under SubGroups A-C are structurally distinct and would possibly have different mode of actions or operations. Each of the different species would therefore require different patentability determinations under the different statutes.

For Group III:

A). Compound species

1. Compound recited in claim 45
2. Compound recited in claim 46
3. Compound recited in claim 47

B). Functional Groups:

1. Carboxyl
2. Hydroxyl
3. Keto
4. Amino
5. Nitro
6. Sulfhydryl

Each of the species under SubGroup A and SubGroup B are structurally distinct and would possibly have different mode of actions or operations. Each of the different species would therefore require different patentability determinations under the different statutes.

For Group IV:

1. Compound recited in claim 50
2. Compound recited in claim 51
3. Compound recited in claim 52
4. Compound recited in claim 53

Each of the species under this Group is structurally distinct and would possibly have different mode of actions or operations. Each of the different species would therefore require different patentability determinations under the different statutes.

For Group V:

A). Functional Groups:

1. Carboxyl
2. Hydroxyl
3. Keto
4. Amino
5. Nitro

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## 6. Sulfhydryl

Each of the species under this Group is structurally distinct and would possibly have different mode of actions or operations. Each of the different species would therefore require different patentability determinations under the different statutes.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species e.g., for each of the subgroups i.e., a single species for Subgroup A, Subgroup B and Subgroup -C recited in e.g., Group II (if Group II is the elected Group) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 24, 44, 49, 54 are generic.

Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant

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must indicate which are readable upon the elected species. MPEP  
§ 809.02(a).

Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).



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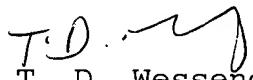
**REASSIGNMENT OF LOCATION**

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit **1639**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (703) 308-3967. The examiner can normally be reached on Flexitime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (703) 306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7924 for regular communications and (703) 308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
T. D. Wessendorf  
Primary Examiner  
Art Unit 1639

tdw  
April 17, 2003